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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/624,020 | 07/21/2003 | Michael Seul | PARSE-C4 | 5081 |
| 7590 03/31/2005 | | | EXAMINER | |
| Bioarray Solutions 35 Technology Drive Warren, NJ 07059 | | | DO, PENSEE T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1641 | |
| DATE MAILED: 03/31/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

LD

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/624,020 | SEUL ET AL | |
| | Examiner | Art Unit | |
| | Pensee T. Do | 1641 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 47-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Okano et al. (US 6,183,970).

Okano teaches a substrate (1) made of plastic. (fig. 1B). A concave portion which is surround by a hydrophobic portion (5) whose surface is subjected to hydrophobic treatment and which has a flat base face and further plural of small holes having upper and lower open ends arranged in the form of cross stripes and formed in the base face of the concave portion. A hydrophilic portion (4) whose surface is subjected to hydrophilic treatment formed between the hydrophobic region and the base face of the concave portion. The hydrophobic and hydrophilic portions make it possible to hold the sample solution easily in the concave portion having the small gels in which the gels are held. These small gels are in the hydrophilic regions and can accommodate an array of particles (oligonucleotide probes) for binding with biological reagents (complementary oligonucleotide probes). (see col.10, lines 55-65). The sides of the small holes are irradiated with light and detection of fluorescence is recorded. (see col. 6, lines 25-67;

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figures 1-A, 1B). A great amount of oligonucleotide probes can be fixed into the gel matrix. (see col. 16, lines 24-26).

Claims 47-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Wagner et al. (US 6,406,921).

Wagner teaches a protein-coated substrate for parallel screening of biomolecular activity. The substrate is made of silicon. A plurality of different members of a single protein family may be immobilized on the protein coated substrate. The substrate having a surface; and one or more protein immobilization regions on said surface, said protein immobilization regions each comprising an ordered hydrophobic monolayer formed of alkyl chain having proximal ends which are absorbed to the surface within the immobilization region and opposite hydrophobic distal ends; a hydrophilic monolayer attached to said ordered hydrophobic monolayer, the hydrophilic monolayer comprising hydrophilic chains, each chain having a proximal end by which said hydrophilic chain is linked to an alkyl chain distal end, and an opposite hydrophilic distal end; and a plurality of functional groups attached to the hydrophilic/hydrophobic monolayers for covalently attaching protein-capture agents to said hydrophilic/hydrophobic monolayers within said immobilization layers. The proteins can attach to the functional groups on the hydrophilic region and to form a monolayer (an array of protein or particles) to bind the complementary proteins of interest from the sample. (see col. 14, lines 10-26). The hydrophilic regions are within the perimeter of indentations in the planar surface of the substrate and the indentations being surrounded by the hydrophobic regions. (see claim 1; example 1).

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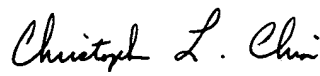
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is 571-272-0819. The examiner can normally be reached on Monday-Friday, 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pensee T. Do
Patent Examiner
March 19, 2005


CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800-1641
3/21/05